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| Application Number | 09/745,098 |
| Filing Date | 12/20/2000 |
| First Named Inventor | Carlos Orlando Vilacha Zaroni |
| Art Unit | 3727 |
| Examiner Name | Nathan Jeffrey Newhouse |
| Attorney Docket Number | 286765-00001 |

Total Number of Pages in This Submission

ENCLOSURES (Check all that apply)

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| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please Identify below): RETURN POSTCARD |
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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|-------------------------------|--|
| Firm or Individual name | David C. Jenkins Eckert Seamans Cherin & Mellott, LLC |
| Signature | |
| Date | November 11, 2005 |

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Examiner: Nathan Jeffrey Newhouse

Group Art Unit: 3727

In re application of:

Carlos Orlando Vilacha Zanoni

Serial No.: 09/745,098

Filed: December 20, 2000

**CROWN CLOSURE HAVING A
REDUCED RADIUS AND METHOD
OF MANUFACTURE**

Attorney Docket No. 286765-00001

REPLY TO EXAMINER'S ANSWER

November 11, 2005

Commissioner for Patents
MAIL STOP APPEAL BRIEF - PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Examiners Answer, dated September 22, 2005, the time for response being before November 22, 2005.

No fee is believed to due; however, if any fee is due please charge any additional fees or credit any overpayment to Eckert Seaman's Deposit Account No. 02-2556. A duplicate copy of this sheet is enclosed.

Argument

In the Examiner's Answer, the Examiner has restated the rejections of the claims substantially as set forth in the final Office Action dated March 24, 2005. The Examiner has further provided a response to the Appellant's arguments. With regard to the rejections of the claims, Appellant relies on his prior arguments as set forth in the Appeal Brief. In reply to the Examiner's response, Appellant provides the following remarks.

Claims 1 and 7; Rejected Under 3 U.S.C. § 102(b)

Claims 1 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Punte* (U.S. Patent No. 2,327,455). It is the Appellant's position that *Punte* discloses a crown closure structured to engage a bottle without a pad or liner. Initially, the Examiner contends that *Punte* discloses a crown closure with a liner. In support of this contention the Examiner cites definitions of "liner" and "lining" from Webster's II New Riverside University Dictionary. Appellant notes first that the definitions are not attached to the Examiner's Answer, and as such, Appellant cannot address the accuracy of the Examiner's interpretation of these definitions. Further, these definitions were not provided to the Appellant prior the filing of the Notice of Appeal. As such, to the extent the Examiner is attempting to introduce new evidence, pursuant to 37 C.F.R. § 41.39(b) the Examiner should have indicated that the Answer includes a new ground of rejection so that Appellant could request that prosecution be reopened. As the Examiner failed to indicate that the Answer includes a new ground of rejection and as Appellant cannot now introduce his own evidence, Appellant requests that this portion of the Examiner's Answer be stricken.

To the extent that the Appellant may respond to this portion of the Examiner's Answer without introducing new evidence, it is noted that the Examiner did not find a definition of "liner" that included a fluid material, such as a sealing compound. That is, the Examiner is relying on the definition of "lining," as opposed to "liner," which is not used in the claims. Further, the use of dictionary definitions for interpreting claim language must be limited to how such words are used by those skilled in the art. That is, as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314, 1322-23, 75 USPQ2d 1321, 1326-27, 1334 (Fed Cir. 2005):

Because the meaning of a claim term as understood by persons of skill in the art is often not immediately apparent, and because patentees frequently use terms **idiosyncratically**, the court looks to “those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean.” ... Those sources include “the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.”

Id. (emphasis added). In this application, the history of crown closures is discussed and it is noted that, originally, cork was used to seal the closures. The cork was subsequently replaced with a “plastic liner.” Application page 1, line 35. As such, as used in this application, a liner is a rigid, or semi-rigid, material such as plastic or cork.

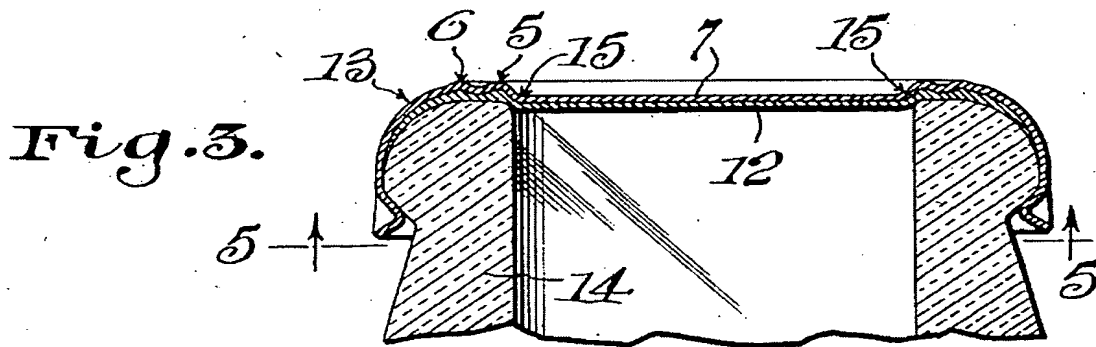
Further, even if the definition of “lining” set forth by the Examiner was relevant to the present application, it is noted that a fluid material, such as the “sealing compound” of *Punte*, is not typically referred to as a “lining.” In the common vernacular, a sealing compound would be referred to as a “coating.” A coating is typically a fluid, or semi-fluid, material that is applied directly to a surface. A “lining,” on the other hand, is generally a rigid or semi-rigid structure, such as a cloth “lining” for a garment, that must be attached to another object. The interpretation of the word “liner” as a non-fluid structure is supported by the use of the words in Claim 1 of the present application, especially when compared to the words used in Claim 1 of *Punte*. That is, claim 1 of the present application recites that the “liner is secured to said inside [of the shell].” Appellant is unaware of any adhesive or fastener that could be used to “secure” the sealing compound of *Punte* to a crown closure. Conversely, claim 1 of *Punte* states that the sealing compound is “adhered” to the skirt portion of the cap. As such, it is clear that a “liner,” as used in the claims of the present application means a rigid or semi-rigid structure as opposed to a fluid sealing compound.

The Examiner further asserts that the serrations of *Punte*, according to the language used in the specification, are reshaped or deformed to conform “perfectly” to the sealing surface of the neck of the bottle. Appellant first notes that this hyperbole of *Punte* is inoperative. That is, as anyone who has attempted to smooth a bend from a sheet metal, *e.g.* foil, knows, a residual deformation will remain. Turning

from common experience to the law, it is noted that, “[t]he prior art reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.” *Motorola Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461 (Fed. Cir 1997). Here, *Punte* states that,

When the cap is applied to the neck of the bottle or other container in the manner illustrated in Figure 3 of the drawing, the sealing portion 8 of the crown top and the turn thereof at 9 into the skirt 10 are reshaped or deformed as at 13 to conform perfectly to the sealing surface presented by the neck 14 of the bottle or other container and to spread and reshape the engaged portion of the sealing compound so as to additionally assure the provision of a perfect seal.
Page 2, left col. Lines 20-29.

Figure 3 is reproduced below:



Thus, despite the fact that the specification states that the application of the cap is “illustrated in Figure 3,” this Figure does not actually teach one skilled in the art how a crown closure having serrations is applied and converted into a cap matching the contour of a bottle “perfectly.” Moreover, *Punte* is internally inconsistent. That is, in the paragraph quoted above, *Punte* states that the, “sealing portion 8 of the crown top and ... the skirt 10 are reshaped or deformed as at 13 to conform perfectly to the sealing surface presented by the neck 14 of the bottle.” However, as clearly shown in Figure 3, due to the presence of the sealing compound 12, the crown top and skirt are spaced from the neck of the bottle at point 13.

Finally, the Examiner has made a conclusion that is not supported by the *Punte* specification. That is, the Examiner has stated that because *Punte* states that the cap “conforms perfectly” to the bottle, the serrations must not exist. However, in

the paragraph extending from page 1 to page 2, the *Punte* specification states that the “crimps” located on skirt 10 (which is deformed at point 13) exist after deformation and “impart rigidity to the skirt.” Thus, it is clear that, even after deformation, the crimps which extend over the length of the skirt survive. Thus, while *Punte* states that the skirt is reshaped or deformed to conform perfectly to the sealing surface presented by the neck of the bottle, *Punte* further states that the serrations still exist. As such, *Punte* does not disclose “a curved portion and a plurality of serrations which do not project into said curved portion” as recited in claim 1 of the present application.

The Examiner further states that only the “portion of *Punte* of the reshaped or deformed portion 13 above the serrations and below the top of the crown closure” is being considered as the “curved portion” in support of the rejection. However, Appellant notes that this portion, which is shown in Figure 3 above, is not “adapted to be the same shape as the mouth contour of a bottle” as recited in Claim 1. That is, as noted above, Figure 3 clearly shows that, due to the presence of the sealing compound 12, the crown top and skirt are spaced from the neck of the bottle at point 13. As the crown top and skirt are spaced from the neck of the bottle at point 13, *Punte* cannot disclose a “curved portion adapted to be the same shape as the mouth contour of a bottle” as recited in Claim 1.

Accordingly, Appellant requests that the Examiner’s rejection of Claims 1 and 7 under 35 U.S.C. §102(b) be reversed.

Claims 2-6 and 8-12; Rejected Under 35 U.S.C. § 103(a)

Claims 2-6 and 8-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Punte* (U.S. Patent No. 2,327,455) in view of *Leenaards* (U.S. Patent No. 3,827,594). The Examiner asserts that the combination of *Punte* and *Leenaards* is obvious and has cited *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir 1992) for the proposition that “obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art.” Answer at 6-7. The Examiner further indicated that “it would have been obvious to one having ordinary skill in the art to make the crown closure of *Punte* with ... the specifications

or dimensions [of *Leenaards*].” *Id.* at 7. The Examiner, however, has not applied the standard set forth in the cases cited in the Office Action.

In *Fine*, the court initially notes that the PTO has the burden of establishing a *prima facie* case of obviousness and further states that, “this burden [can be satisfied] only by *showing* some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” 5 USPQ2d at 1598 (emphasis added). The court then noted that the Examiner in that case had failed to show the requisite teaching or suggestion in the cited references and that the Examiner’s “bald assertion” without any support or explanation did not satisfy the PTO’s burden. *See*, 5 USPQ2d at 1599. Similarly, the court in *Jones*, which cited *Fine* to establish the rule, noted that because the PTO failed to present any evidence that one skilled in the art would have been motivated to combine the cited references, the PTO did not establish a *prima facie* case of obviousness. *See*, 21 USPQ2d at 1944.

Here, the rejections under 35 U.S.C. §103(a) are improper because the Examiner has not *shown* that there is a suggestion that the cited references should be combined. The Examiner, essentially, makes a bald assertion that the references may be combined. That is, the Examiner has simply cited selected elements from two different references and said they may be combined. Such a combination, however, has not been supported by any evidence. The Examiner’s error is rooted in the misinterpretation of the rule set forth in *Fine*. The Examiner contends that “obviousness can only be *established by combining or modifying* the teachings of the prior art.” However, *Fine* actually states that the PTO’s burden can be satisfied only by *showing* that knowledge generally available to one of ordinary skill would lead to the combination of the relevant teachings of the references. Accordingly, in this application, as in *Jones*, the Examiner has failed to present any “*evidence*, other than the PTO’s speculation (if it can be called evidence) that one skilled in the art would have been motivated [to combine the references]” 21 USPQ2d at 1944 (emphasis in original). As such, in this application, as in *Jones*, “the PTO did not establish a *prima facie* case of obviousness....” *Id.*

As the Examiner has failed to properly support the rejections under 35 U.S.C. §103(a), the Board should reverse the Examiner’s rejections of Claims 2-6 and 8-12 under 35 U.S.C. §103(a).

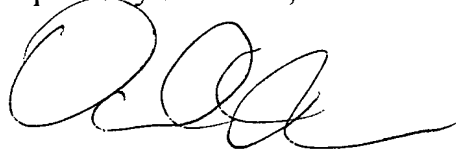
Claim 13; Rejected Under 35 U.S.C. § 103(a)

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Punte* (U.S. Patent No. 2,327,455) in view of *Ferngren* (U.S. Patent No. 2,099,056). The Examiner asserts that the combination of *Punte* and *Ferngren* is obvious and has again cited *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir 1992). As set forth above, the Examiner has not interpreted properly. Further, it is noted that the Examiner has merely stated that specific elements of Claim 13 are represented in the prior art. Appellant notes that *In re Fine* held that, although some of the cited references may, individually, have some of the claimed inventions' features, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention [without some suggestion that the art be combined]." *Id.* at 1075.

Conclusion

It is submitted that Claims 1-13 are patentable over the prior art. Therefore, Appellant respectfully requests that the Board reverse the Examiner's rejections of Claims 1-13 and remand the application to the Examiner for the issuance of a Notice of Allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. C. Jenkins', with a long horizontal flourish extending to the right.

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